

Page 4
Serial No. 10/662,599
Response to Official Action

In the Drawings

There are no amendments to the drawings.

Remarks

Applicant makes no amendment to the claims and presents the following Remarks of which, favorable consideration is earnestly requested.

35 U.S.C. 102(a) Rejections

The Examiner has rejected Claim 19 under 35 U.S.C. 102(a) as anticipated by U.S. Patent No. 6,411,851 ("Winkler"). Applicant respectfully disagrees. Claim 19 requires among other limitations, a medical video instrument generating an image stream for display on a touch screen. Applicant respectfully submits that Winkler fails to disclose this limitation.

For example, Winkler discloses a "magnetic programming head 218", which "is configured to assist with programming an implantable medical device, perform programming and data transmission functions in cooperation with a remote data center." (Col. 12, lines 54 – 56 & 66; Abstract.) In fact, the title of the invention of Winkler is "Implantable Medical Device Programming Apparatus Having An Auxiliary Component Storage Compartment" (Title of the Invention.) Nowhere however, does Winkler disclose a medical video instrument generating an image stream for display on a touch screen as required by Claim 19.

The Examiner has submitted that Applicants arguments were not persuasive, in part because, "Applicant does not recite a magnetic programming head which generates an image stream" or that "Applicant does not recite an IMD which provides a

video feed.” (Official Action, pp. 3-4.) Applicant does not suggest that the present claims include the limitation of a magnetic programming head or an IMD device.

Rather, Applicant submitted the magnetic programming head (which the Examiner has equated to the “medical video instrument” required by Claim 19), disclosed in Winkler, does not generate an image stream and therefore cannot anticipate Claim 19.

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (It is well settled that “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”) As Applicant expects the Examiner is aware, all limitations of all claims must be considered, because it is improper to fail to consider any limitation in the claims. *In re Geerdes*, 491 F.2d 1260, 1262, 180 U.S.P.Q. 789, the 791 (CCPA 1974). Therefore, because Winkler fails to disclose a medical video instrument generating an image stream for display on a touch screen as required by Claim 19, Winkler cannot anticipate Claim 19.

Obviousness

Applicant respectfully submits that Claim 19 cannot be obvious in view of Winkler as the magnetic programming head cannot accomplish the same functionality as the present invention. For example, the specification states that “[t]he present invention relates generally to [a] device for video recording and image capture, and more particularly to such a device for image based documentation of surgical procedures.” (Par. 2) (emphasis added.) Winkler is directed toward a “portable programming

apparatus” that comprises a magnetic programming head configured to assist in programming an IMD, which may comprise “implantable cardiac pacemakers.” (Col. 1, line 8; Col. 4, lines 66 – 67.) Nowhere does Winkler even hint that a medical video instrument generates an image stream for display on a touch screen. Accordingly, to arrive at Claim 19, Winkler would have to be completely redesigned.

It is well settled that the mere fact that references can be modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. See, e.g., MPEP 2143.01; *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (fact that prior art “may be capable of being modified to run the way the apparatus is claimed, there must be some suggestion or motivation in the reference to do so.”). In the present case, Applicant respectfully submits that, First, it is not clear whether Winkler could even be modified according to the presently pending claims; and Second, there is absolutely no suggestion in Winkler to abandon the magnetic programming apparatus to replace it with a device capable of generating an image stream for display on a touch screen as required by Claim 19.

Applicant further respectfully submits that there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make a modification and that “knowledge can not come from the applicant's invention itself.” *In re Oetiker*, 977 F.2d, 1443, 1447 (Fed. Cir. 1992). See also *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (suggestion to combine must be found in the prior art, not the applicant's

disclosure). In the present case, Applicant respectfully submits that, a fair reading of Winkler provides no motivation for modification according to the presently pending claims as Winkler is not directed toward a system that can generate image data, but rather the magnetic programming device is exactly what it suggests, a magnetic device used to program an implantable medical device such as a pace-maker.

It is also well settled that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case, Applicant respectfully submits that the intended purpose of the IMD taught in Winkler is to regulate a vital body function, while the “programming apparatus 200” allows a user to program the IMD by means of programming head 218. (See, Col. 4, lines 66 – 67; Col. 11, lines 63-64; See *also*, Col. 13, lines 1-7.) Modification of the IMD to instead provide a video feed to a physician performing a surgical procedure would destroy the purpose of “programming apparatus 200.” (Col. 13, line 2.) Accordingly, such a modification according to presently pending Claim 19 cannot be obvious.

The Examiner has further submitted that Applicants arguments were not persuasive, in part because, “touch screens inherently display a video stream; display of a video stream is one of the necessary functions of a touch screen.” (Official Action, p. 4.) Applicant respectfully disagrees.

The Examiner appears to be stating that because a user can see information on a touch screen that the information presented inherently comprises a video stream. The present invention is directed to "image based documentation of surgical procedures." (Par. 2.) Claim 19 requires "a medical video instrument generating an image stream for display on a touch screen." There is no way that Winkler can provide an image of the inside of the patient's body or provide that image data as a video feed that is displayed on a touch screen. Rather, the touch screen disclosed in Winkler is provided as a programming interface for the user to program the IMD. (Col. 12, lines 34-39 "Display screen 206 is the primary input medium for programmer 200.") Nowhere does Winkler teach, disclose or suggest that image data is displayed on is capable of being displayed on the touch screen.

It is respectfully submitted that claims 19-31 and 46-48, all of the claims remaining in the application, are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,

April 11, 2006


Wesley W. Whitmyer, Jr., Registration No. 33,558
Steven B. Simonis, Registration No. 54,449
Attorneys for Applicant
ST. ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155